

REMARKS

The final Office Action, mailed February 1, 2006, considered and rejected claims 1-6, 8-19, 21-25, 28, 29 and 31. Claims 1-4, 8-10, 12-17, 21-23, 25, 28, 29 and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaughnessy (U.S. Patent No. 5,928,325) in view of Bliss (U.S. Patent No. 6,654,789). Claims 5 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaughnessy in view of Bliss and further in view of Malmstrom (U.S. Patent No. 5,901,359). Claims 6 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaughnessy in view of Bliss and further in view of Kennedy (U.S. Patent No. 6,018,657). Claims 11 and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaughnessy in view of Bliss and further in view of Olsson (U.S. Patent No. 5,915,222).¹

By this paper, claims 1, 4, 5, 13, 14 and 29 have been amended, claim 32 added, and no claims have been cancelled.² Accordingly, following this paper, claims 1-6, 8-19, 21-25, 28, 29, 31 and 32 remain pending, of which claims 1, 14 and 29 are the only independent claims at issue.

Embodiments of the present invention are generally directed to the selection and use of different types of messaging systems to communicate with a message recipient. Claim 1, for example, recites a method for enabling the sending of messages to a recipient via any of a number of messaging systems of different types. In this claimed embodiment, addresses are stored for the recipient, while the recipient chooses at least one of the stored addresses as a preferred address for communication with the recipient. Additionally, information about the availability of the recipient over the messaging systems is received from the messaging systems and interpreted to determine in which messaging systems the recipient is currently available, while the recipient is considered to be available in at least the messaging system associated with the preferred address selected by the user. Originator input is also received that includes an identification of the recipient as well as a message and the messaging system associated with the preferred address is identified. After identification of the messaging system associated with the preferred address, the message is sent from the user device of the

¹ Although the prior art status of the cited art is not being challenged at this time, Applicants reserve the right to challenge the prior art status of the cited art at any appropriate time, should the need arise. Accordingly, any arguments and amendments made herein should not be construed as Applicants acquiescing to any prior art status of the cited art.

² Support for the amendments to the claims, and for the new claim, is found throughout Applicants' disclosure. For example, among other passages, paragraphs 23, 32 and 33 of the originally filed application provide support for the amendments and new claims.

originator to the recipient by way of the associated messaging system. The method also includes receiving a recipient selection of a different stored address as a new preferred address for communication with the recipient.

Claims 14 and 29, which recite similar limitations to those of claim 1, are directed to a system for enabling the sending of messages to a recipient (claim 14) and a computer-readable medium having computer-executable instructions for performing the method of claim 1 (claim 29).

While Shaughnessy and Bliss are generally directed to communication systems, Applicants respectfully submit that the cited art fails to make obvious the claimed invention. For example, the cited art fails to disclose or suggest, among other things, a system in which a message is sent from the user device after identifying the messaging system associated with a preferred address selected by the recipient, as recited in combination with the other recited elements. In fact, the Shaughnessy patent, which is the primary reference cited in the Office Action, appears to disclose the opposite.

Shaughnessy discloses a method of determining to which of a recipient's multiple user devices to direct a message. In Shaughnessy's method, a central agent of the system, receives a message from the sender and identifies the intended recipient of the message and what user devices are assigned to the intended recipient. (Col. 4, ln. 66 to Col. 5, ln. 6). Thereafter, the central agent identifies networks servicing the user devices and obtains information as to which devices are currently available to the user. (Col. 5, ll. 7-16). The central agent then uses predetermined rules to select which device receives the message from the sender. (Col. 5, ll. 17-20). Such rules may involve a simple look-up operation, or may require a decisional operation based on the format of the original message received by the central agent, the message source, or the usefulness of a specific type of message to the user's device. (Col. 5, ll. 20-28).

In other words, Shaughnessy discloses a system in which a sender's user device sends the message *before* the central agent identifies a messaging system associated with an address to which the message is to be directed. Such a teaching is in direct contrast to embodiments of Applicants' claimed invention in which the sender's user device sends the message only *after* identification of a message system associated with an address to which the message is to be directed. In this regard, Applicants also submit that it would not make sense to combine Shaughnessy with other art to reject the claims inasmuch as modifying the Shaughnessy system in the claimed manner would make

Shaughnessy's system inoperable. In particular, Shaughnessy makes it clear that identification of the recipient, recipient user devices, and associated networks are all determined only *in response to detection of the incoming message*. Stated another way, the message sent *from the user device* is the trigger to the dynamic device selection features in Shaughnessy, such that modification in the claimed manner would "require a substantial reconstruction and redesign of the elements shown [in the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate, which would be improper. (M.P.E.P. § 2143.02(VI)).

The Bliss patent also fails to remedy these noted deficiencies of Shaughnessy. For example, Bliss is generally directed to a system in which a user may register with a web site to indicate that a preferred email address, URL, ICQ number, or chat handle is to be used by others in contacting the user. Subsequent to such registration, another may use the system to search for and retrieve the preferred information. Bliss fails, however, to provide any teaching about sending a message from an originator user device, in the manner claimed, and particularly that only after identifying a messaging system associated with a preferred address selected by a recipient, as claimed in combination with the other recited claim elements. Furthermore, even if Bliss did teach or suggest such an embodiment, which it doesn't, Applicants respectfully submit that there is no suggestion or motivation to combine references in the manner suggested in the Office Action.

With specific regard to the requisite motivation for combining the art, Applicants also respectfully submit that an appropriate motivation has not been provided for combining the cited art. While the Office Action does state that there is a motivation to combine the references, namely to allow the Shaughnessy system the capability to search and match new and old email addresses of an entity to prevent email messages from being delivered to unused addresses, (Office Action, pp. 4-5), Applicants, respectfully submit that this motivation is insufficient for combining the cited references. In particular, it is error to reconstruct Applicants' claimed invention from the prior art by using Applicants' claim as a "blueprint." When prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight obtained from Applicants' disclosure itself. It is critical to understand the particular results achieved by the new combination. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 227 U.S.P.Q. 543 (Fed. Cir. 1985). "The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a

finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of applicant's specification, to make the necessary changes in the reference device." *Ex parte Chicago Rawhide Mfg. Co.*, 223 U.S.P.Q. 351, 353 (Bd. Pat. App. & Inter. 1984) (emphasis added).

Accordingly, Applicants submit that the rejections set forth in the Office Action are improper because the Office Action has not set forth a proper motivation to combine references. In particular, Shaughnessy is directed to embodiments for determining at which "devices" a recipient is currently available. Bliss, on the other hand, is directed to embodiments that disclose which "email address" the user currently prefers (e.g., checks the most frequently). In combining the art, the Office Action appears to equate "email addresses" as being tantamount to "user devices," without providing any justification for such a leap. Accordingly, it appears as though the purported motivation for combining the art actually comes from Applicants' claimed invention itself, relying on improper hindsight reconstruction. In particular, the Office Action states that user devices can be considered "addresses" in order to match Applicants' claim language without addressing the inherent conflict between the definitions of Bliss's email addresses and Shaughnessy's devices and without giving appropriate consideration to how an *email address* of the Bliss system can be implemented into the Shaughnessy system which discloses methods for selecting among different *devices*.

Furthermore, with specific regard to this inherent conflict of definitions and applications, Applicants also submit that there is no reasonable expectation of success when interchangeably using the email addresses of Bliss with the device selection system of Shaughnessy. In particular, a central purpose of the Shaughnessy system is to determine at which device a user can be located. To do so, an HLR is used to identify a wireless device of a user and to determine whether an incoming message will be received. There is not, however, any suggestion that an HLR or any other similar device or system would be used to determine whether a user is currently accessing his/her selected email address. In fact, Applicants submit that, at best, the Bliss system only determines which email address is most frequently checked.

Accordingly, Applicants submit that the proposed combination of the art and purported motivation for their combination is based on hindsight reconstruction, without a full consideration of the effects of the combination on the cited art, and is therefore improper. In particular, the supplied

motivation fails to provide any suggestion or motivation as to why a person of ordinary skill in the art would be motivated to modify the *device* selection system of Shaughnessy with only *email address* set-up features of Bliss.

Independent claims 14 and 29, as well as each of their dependent claims, are allowable for at least the reasons presented above with respect to claim 1.

Although not necessary, Applicants will now address new dependent claim 32. As recited in claim 32, a method includes receiving a recipient selection of at least one stored address as a preferred address, wherein the selected address includes a preferred address that is unique to a particular user device of the recipient. As noted in the Office Action, Shaughnessy fails to teach or suggest receiving a recipient selection of at least one of the stored addresses as a preferred address for communication. (Office Action, p. 4). Applicants also submit that Bliss fails to remedy the failings of Shaughnessy on this point. In particular, while Bliss teaches a registration and query system for searching email addresses, URLs, IRQ numbers, and chat handles, Bliss clearly fails to teach or suggest that any such address, URL, IRQ number or chat handle is unique to a particular recipient user device. In fact, it appears that a user can use any of a number of different devices to access the same email services, URLs, IRQ and chat systems. Accordingly, it is clear that both Shaughnessy and Bliss fail to disclose or suggest any embodiment in which a recipient selects an address, as a preferred address, that is unique to a particular user device of the recipient, as claimed.

In view of the foregoing, Applicants respectfully submit that all of the other rejections to the claims are now moot and do not, therefore, need to be addressed individually at this time. In light of the foregoing, it will be appreciated, however, that silence with regard to any rejection should not be construed as Applicants acquiescing to any of the purported teachings or assertions made in the last action regarding the cited art or the pending application, including any official notice. Instead, Applicants reserve the right to challenge any of the purported teachings or assertions made in the last action at any appropriate time in the future, should the need arise. Furthermore, to the extent that the Examiner has relied on any Official Notice, explicitly or implicitly, Applicants specifically request that the Examiner provide references supporting the teachings officially noticed, as well as the required motivation or suggestion to combine references with the other art of record.

For at least the foregoing reasons, Applicants submit that the claimed invention is allowable over the cited art. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 30th day of June, 2006.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Jens C. Jenkins', written in a cursive style.

JENS C. JENKINS

Registration No. 44,803

COLBY C. NUTTALL

Registration No. 58,146

Attorneys for Applicant

Customer No. 022913

Telephone No. 801.533.9800

JCJ:CCN